

III. Remarks

A. Status of the Application

Claims 1-28 were previously pending, with claims 13-16 and 21-28 having been withdrawn from consideration.

Claims 4, 5, 13-16 and 21-26 have been canceled without prejudice or disclaimer.

Claims 1, 17 and 18 have been amended.

Claim 29 has been added.

As a result, claims 1-3, 6-12, 17-20 and 27-29 are pending, with claims 27 and 28 withdrawn from consideration.

Favorable consideration of this application is respectfully requested.

B. Support for Amendments to Claims 1, 17 and 18

As noted above, claims 1, 17 and 18 have been amended. The added phrase "one of a plate body and a prism, the one of the plate body and the prism defining a plane surface of the wound body" is supported by at least claims 4 and 5 of the application as originally filed. The added phrase "wherein the foundation member is wound around the one of the plate body and the prism in accordance with a winding route so that: portions of the foundation member are arranged on the plane surface of the wound body and are spaced in a parallel relation on the plane surface," and the added phrase, "wherein the distributing section distributes the samples on the wound foundation member in distribution positions of the respective samples provided at the distribution intervals along the winding route of the foundation member," are at least supported by the text from page 6, line 32 to page 7, line 1 of the specification as originally filed, namely "the samples are not directly distributed on the wound body, but are distributed on the foundation member wound around the wound body," and the text on page 9, lines 3 to 6 of the specification as originally filed, namely "localizes the samples within a fixed range on the foundation member, in distribution positions of the respective samples provided at distribution intervals of the column or line along a winding route of the foundation member which has been provided in parallel at winding intervals of the line or column of the predetermined matrix."

C. Rejection Under 35 U.S.C. §102(b)

Claims 1-4, 6-12 and 17 stand rejected under 35 U.S.C. §102(b) over U.S. Patent Application Publication No. 2001/0046699 (the "Tajima Publication"). As noted above, claim 4 has been canceled without prejudice or disclaimer. Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

The PTO provides in MPEP §2131 that:

"[t]o anticipate a claim, a reference must teach every element of the claim."

Therefore, to support a rejection under 35 U.S.C. §102 with respect to a claim, the Tajima Publication must contain every element of the claim.

Amended claim 1 recites:

A sample arraying/assembling device comprising:

a distributing section which is capable of holding respective solutions containing samples to be distributed, the distributing section comprising a plurality of holding ends arranged in a predetermined matrix; and

a wound body comprising:

one of a plate body and a prism, the one of the plate body and the prism defining a plane surface of the wound body; and

a string-like or thread-like slender foundation member on which samples are to be distributed at distribution intervals of column or line of the matrix, wherein the foundation member is wound around the one of the plate body and the prism in accordance with a winding route so that:

portions of the foundation member are arranged on the plane surface of the wound body and are spaced in a parallel relation on the plane surface at winding intervals of the line or column of the matrix; and

respective holding ends of the distributing section can come into contact with the foundation member;

wherein the distributing section distributes the samples on the wound foundation member in distribution positions of the respective samples provided at the distribution intervals along the winding route of the foundation member.

The Tajima Publication discloses a spiral disk shaped carrier 70 for substance detection which is manufactured by dispensing a plurality of parallel lines 31 (of a variety suspensions which contain substances) on an unwound piece of film 22; as a result, the lines 31 (and thus the substances) are spaced along the longitudinal length of the unwound film 22 (*See* Tajima Publication, Figure 2 and paragraphs [0097]—[0100]). The film 22 is spirally wound about a cylindrical core 24, and then a thin slice is cut in a direction perpendicular to the longitudinally-

extending axis of the cylindrical core 24 to thereby form the carrier 70 (*See id.* at Figs. 7(a) and 7(b) and paragraphs [0109]—[0111]). As a result, as shown in Fig. 7(b) of the Tajima Publication, the film 22 is spirally wound around the circumferentially-extending surface of the cylindrical core 24.

Contrary to the subject matter of amended claim 1, however, the Tajima Publication does not disclose a distributing section that distributes the substances on the wound film 22 in distribution positions of the respective substances provided at the distribution intervals along the winding route of the film 22.

In further contrast to the subject matter of amended claim 1, the Tajima Publication does not disclose that the film 22 is wound around the cylindrical core 24 so that portions of the film 22 are arranged on a plane surface and are spaced in a parallel relation on the plane surface at winding intervals. Instead, the film 22 is spirally wound around the cylindrical core 24, as shown in Fig. 7(b) of the Tajima Publication.

In still further contrast to the subject matter of amended claim 1, the Tajima Publication does not disclose a plane surface, and further does not disclose either a plate body or a prism, which defines the plane surface.

Therefore, a rejection of amended claim 1 based on 35 U.S.C. §102(b) cannot be supported by the Tajima Publication.

Claims 2, 3 and 6-12 depend upon and include the subject matter of amended claim 1 and therefore are allowable for at least the same reasons as noted above in connection with amended claim 1.

Amended claim 17 recites:

A sample arraying/assembling device comprising:

- a distributing section which is capable of holding respective solutions containing samples to be distributed, the distributing section comprising a plurality of holding ends arranged in a predetermined matrix;
- a wound body defining a plane surface, the wound body comprising a string-like or thread-like slender foundation member on which samples are to be distributed at distribution intervals of column or line of the matrix, wherein the foundation member is wound in accordance with a winding route so that:
 - portions of the foundation member are arranged on the plane surface of the wound body and are spaced in a parallel relation on the plane

surface at the winding intervals of the line or column of the matrix;
and
respective holding ends of the distributing section can come into contact
with the foundation member;
a detachably provided core to which one end of said foundation member is
attached, and which is to be wound with said foundation member; and
a foundation member rolling section which sequentially takes out said foundation
member from said wound body while rolling it up around said core at
narrower intervals than said winding intervals; so as to assemble and
arrange said foundation member;
wherein the distributing section distributes the samples on the wound foundation
member in distribution positions of the respective samples provided at the
distribution intervals along the winding route of the foundation member.

As noted above, to support a rejection under 35 U.S.C. §102 with respect to a claim, the
Tajima Publication must contain every element of the claim.

As noted above, the Tajima Publication discloses a spiral disk shaped carrier 70 for
substance detection which is manufactured by dispensing a plurality of parallel lines 31 (of a
variety suspensions which contain substances) on an unwound piece of film 22; as a result, the
lines 31 (and thus the substances) are spaced along the longitudinal length of the film 22 (*See*
Tajima Publication, Figure 2 and paragraphs [0097]—[0100]). The film 22 is spirally wound
about a cylindrical core 24, and then a thin slice is cut in a direction perpendicular to the
longitudinally-extending axis of the cylindrical core 24 to thereby form the carrier 70 (*See id.* at
Figs. 7(a) and 7(b) and paragraphs [0109]—[0111]). As a result, as shown in Fig. 7(b) of the
Tajima Publication, the film 22 is spirally wound around the circumferentially-extending surface
of the cylindrical core 24.

Contrary to the subject matter of amended claim 17, however, the Tajima Publication
does not disclose a distributing section that distributes the substances on the wound film 22 in
distribution positions of the respective substances provided at the distribution intervals along the
winding route of the film 22.

In further contrast to the subject matter of amended claim 17, the Tajima Publication does
not disclose that the film 22 is wound around the cylindrical core 24 so that portions of the film
22 are arranged on a plane surface and are spaced in a parallel relation on the plane surface at
winding intervals. Instead, the film 22 is spirally wound around the cylindrical core 24, as
shown in Fig. 7(b) of the Tajima Publication.

In still further contrast to the subject matter of amended claim 17, the Tajima Publication does not disclose a foundation member rolling section which sequentially takes out said film 22 from said wound body while rolling it up around said core at narrower intervals than said winding intervals; so as to assemble and arrange said film 22. Instead, once the film 22 is spirally wound around the cylindrical core 24, it is not taken out for rolling it up around another core at narrower intervals than said winding intervals.

Therefore, a rejection of amended claim 17 based on 35 U.S.C. §102(b) cannot be supported by the Tajima Publication.

For all of the foregoing reasons, the rejection of claims 1-4, 6-12 and 17 under 35 U.S.C. §102(b) over the Tajima Publication should be withdrawn.

D. Rejections Under 35 U.S.C. §103(a)

1. Claim 5

Claim 5 stands rejected under 35 U.S.C. §103(a) over the Tajima Publication. Claim 5 has been canceled without prejudice or disclaimer and thus any rejection thereof is no longer applicable.

2. Claims 18-20

Claims 18-20 stand rejected under 35 U.S.C. §103(a) over the Tajima Publication, and further in view of U.S. Patent No. 5,895,631 ("Tajima '631"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

Amended claim 18 recites:

A sample arraying/assembling method of distributing samples at once at distribution intervals of column and line of a predetermined matrix, on a string-like or thread-like slender foundation member, comprising:
a holding step for holding respective solutions containing samples to be distributed, on a plurality of holding ends arranged in the predetermined matrix;
providing a wound body, comprising:
providing one of a plate body and a prism, the one of the plate body and the prism defining a plane surface of the wound body; and

winding the foundation member around the one of the plate body and the prism in accordance with a winding route so that portions of the foundation member are arranged on the plane surface of the wound body and are spaced in a parallel relation on the plane surface at winding intervals of the line or column of the matrix;
a contact step for making said respective holding ends contact with said foundation member; and
distributing the samples on the wound foundation member in distribution positions of the respective samples provided at the distribution intervals along the winding route of the foundation member.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The Examiner clearly cannot establish a *prima facie* case of obviousness in connection with amended claim 18 for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ...

(emphasis added).

Here, the cited combination of references fails to disclose at least the following elements of amended claim 18:

1. winding the foundation member around the one of the plate body and the prism in accordance with a winding route so that portions of the foundation member are arranged on the plane surface of the wound body and are spaced in a parallel relation on the plane surface at winding intervals of the line or column of the matrix; and
2. distributing the samples on the wound foundation member in distribution positions of the respective samples provided at the distribution intervals along the winding route of the foundation member.

(emphases added).

In particular, and as noted above, the Tajima Publication discloses dispensing a plurality of parallel lines 31 (of a variety suspensions which contain substances) on an unwound piece of film 22; as a result, the lines 31 (and thus the substances) are spaced along the longitudinal length of the film 22 (See Tajima Publication, Figure 2 and paragraphs [0097]—[0100]). The

film 22 is spirally wound about a cylindrical core 24, and then a thin slice is cut in a direction perpendicular to the longitudinally-extending axis of the cylindrical core 24 to thereby form a carrier 70 (*See id.* at Figs. 7(a) and 7(b) and paragraphs [0109]—[0111]). As a result, as shown in Fig. 7(b) of the Tajima Publication, the film 22 is spirally wound around the circumferentially-extending surface of the cylindrical core 24.

Contrary to the subject matter of amended claim 18, however, the Tajima Publication does not disclose winding the film 22 around the cylindrical core 24 in accordance with a winding route so that portions of the film 22 are arranged on a plane surface of the core 24 and are spaced in a parallel relation on a plane surface of the core 24 at winding intervals. Instead, the film 22 is spirally wound around the cylindrical core 24, as shown in Fig. 7(b) of the Tajima Publication.

In further contrast to the subject matter of amended claim 18, the Tajima Publication does not disclose distributing the substances on the wound film 22 in distribution positions of the respective substances provided at the distribution intervals along the winding route of the film 22. Instead, the substances are distributed on the unwound film 22 and are spaced along the longitudinal length of the film 22.

The secondary reference, namely Tajima '631, is cited as allegedly disclosing a liquid processing method for using a pipette device to pipette a substance from inside a vessel and transferring the substance to another liquid or target, which the Examiner alleges to encompass the holding and contact steps of amended claim 18 (*See* Office Action mailed January 20, 2010, page 8). However, Tajima '631 does not supply the above-noted deficiencies of the Tajima Publication with respect to amended claim 18.

Therefore, a rejection of amended claim 18 under 35 U.S.C. §103(a) cannot be supported by the combination of the Tajima Publication and Tajima '631.

Claims 19 and 20 depend upon and include the subject matter of amended claim 18 and therefore are allowable for at least the same reasons as noted above with respect to amended claim 18.

For all of the foregoing reasons, the rejection of claims 18-20 under 35 U.S.C. §103(a) over the Tajima Publication, and further in view of Tajima '631, should be withdrawn.

E. New Claim

New claim 29 depends upon and includes the subject matter of amended claim 1 and thus is allowable for at least the same reasons as noted above with respect to amended claim 1.

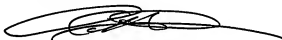
F. Conclusion

It is believed that all matters set forth in the Office Action mailed January 20, 2010 have been addressed. Applicants have made a diligent effort to advance the prosecution of this application by canceling claims 4, 5, 13-16 and 21-26 without prejudice or disclaimer, amending claims 1, 17 and 18, adding claim 29, and submitting arguments in support of the patentability of claims 1-3, 6-12, 17-20 and 29.

In view of all of the above, the allowance of claims 1-3, 6-12, 17-20 and 27-29 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



Alan N. Herda
Registration No. 50,426

Dated: 7/20/10
HAYNES AND BOONE, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, Texas 75219
Telephone: 214/651-5924
IP Facsimile: 214/200-0853
D-1873831